

Remarks/Arguments

Claims 1 to 5, 7 to 9, 17 to 23 and 30 to 40 are pending. Claims 1 to 5, 7 to 9 and 17 to 23 have been amended. Claims 6, 10 to 16 and 24 to 29 have been canceled. New Claims 30 to 40 are drawn to the elected invention.

The Office Action stated that restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 to 9 and 17 to 23, drawn to coating method, classified in class 427, subclass 457.
- II. Claims 10 to 16 and 24 to 29, drawn to apparatus, classified in class 118, subclass 604.

Applicants elect, with traverse, the invention of Group I, Claims 1 to 9 and 17 to 23.

The Office Action stated that the inventions are distinct, each from the other because of the following reasons:

The Office Action stated: that inventions I and II are related as process and apparatus for its practice; that the inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process; that in this case the apparatus can be used for another and materially different process such as applying localized or continuous coatings to non-flexible substrates, the coatings being other than sealants, e.g., paint, reactants, fibers, etc.; and that it is also noted the method alone requires EMB.

The Office Action stated that because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The Office Action stated: that during a telephone conversation with Virgil Marsh on 10/30/05 a provisional election was made with traverse to prosecute the invention of Group I, method claims 1 to 9 and 17 to 23; that affirmation of this election must be made by applicant in replying to this Office Action.

Applicants confirm their election with traverse of the invention of Group I, Claims 1 to 9 and 17 to 23.

The Office Action stated that Claims 10 to 16 and 24 to 29 are withdrawn from further consideration by the Examiner as being drawn to a nonelected invention. Applicants reserve the right to file a divisional and/or continuing application drawn to the nonelected invention of Group II.

The Office Action stated: that applicants are reminded that upon the cancellation of claims to a nonelected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application; and that any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The Office Action stated that acknowledgment is made of applicants' claim for foreign priority based on applications filed in Europe on 10/7/02 and 11/25/02. The Office Action stated that it is noted, however, that applicants have not filed a

certified copy of the EU applications as required by 35 U.S.C. 119(b). Applicants traverse this statement as being incorrect. On September 30, 2003 applicants filed, along with this application, a claim for priority and a certified copy of each of priority European Patent Application Nos. 02405866.1 and 02406019.6.

(Enclosed is a copy of the claim for priority and a copy of the certificate page of each of such priority European patent applications.) Also enclosed is a copy of the Utility Patent Application Transmittal sheet, that recites the certified copy of the priority documents accompanied the application. Further enclosed is a copy of both of the PTO-stamped postcard receipts, that recites that a claim for priority with certified copies of the European patent application were included in the filing.

The Examiner is requested to locate the filed certified copy of each of the two European patent applications, and to acknowledge their receipt in the record.

The disclosure has been objected to because of the following informality: on page 3, lines 27 and 28, the last 2 lines are redundant, "...basis of a printers copy i.e. printers copy".

The Office Actions queried what does this mean; and that appropriate correction is required. This matter has been corrected.

This objection should be withdrawn.

The Office Action stated that applicants are advised that should Claims 3, 4 and 6 to 9 be found allowable, Claims 18 to 23 will be objected to under 37 CFR 1.75 as being a **substantial duplicate thereof**. Applicants traverse this objection. The two groups of claims are not substantial duplicates of each other.

The Examiner has not factually established in the record that the two groups of claims are substantial duplicates of each other. The burden of proof is upon the Examiner and the Examiner has not carried his burden of proof.

The Office Action stated: that, when two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim; and see MPEP §706.03(k). Conclusionary statements are not the same as factual proof.

Claim 3 is directly dependent upon independent Claim 1. All of Claims 4 and 6 to 9 are also directly dependent upon independent Claim 1 (Claim 5 is directly dependent up on dependent Claim 4). None of Claims 3 to 9 include the claimed subject matter of dependent Claim 2, while all of Claims 18 to 23 do, therefore none of Claims 18 to 23 are substantial duplicates of Claims 3 to 9, and vice versa.

This possible objection has no basis in fact or law.

Claims 8 and 22 have been objected to because of the following informality: Claims 8 and 22 read the monitoring thickness of the layer not yet deposited ("to be deposited").

The Office Action stated: that it is suggested "deposited" be inserted before "sealing layer" and the current "to be deposited" be deleted for clarity; and that appropriate correction is required. This matter has been corrected.

This objection should be withdrawn.

The Office Action stated that 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process,
machine, manufacture, or composition of matter, or any new and
useful improvement thereof, may obtain a patent therefor, subject
to the conditions and requirements of this title.

Claim 17 has been rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. Applicants traverse this rejection, for among other reasons, being clearly wrong in law.

35 U.S.C. 100 states:

“35 U.S.C. 100 Definitions.”

“When used in this title unless the context otherwise indicates-

- (a) The term “invention” means invention or discovery.
- (b) The term “process” means process, art, or method,
and includes a new use of a known process, machine,
manufacture, composition of matter, or material.”

[Emphasis Supplied]

While applicants’ claimed process is not known process, Congress has defined the term “process” in the patent statute to include the term “use” in its noun form. Accordingly, this rejection under Section 101 is incorrect on its face.

The Office Action stated see, *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). These decisions are wrong because of 35 U.S.C. 100.

To advance prosecution, applicants have amended Claim 17 to use the step “utilizing”. See M.P.E. P. 2173.05 (q).

This rejection should be withdrawn.

The Office Action stated that the following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The Office Action stated: that Claim 17 provides for the use of “film type laminate”, but, since the claim does not set forth any steps involved in the **method/process**, it is unclear what method/process applicants are intending to encompass; and that a claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Applicants traverse this statement as being clearly in error because of the definition of process in Section 100(b)—see above.

Not only that, the term “use” in its noun form includes a “method”. Webster’s Ninth New Collegiate Dictionary, (1989), states:

“use...n...1...c: a method...of employing or applying something...”

[Emphasis Supplied] [Page 1299]

Claim 2 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants traverse this rejection.

The Office Action stated that Claim 2 is vague and indefinite because the meaning of “a two-component deposition system” is unclear since it is unclear what two components (i.e., 2 formulations, 2 applicators, etc.) form a system for deposition. Applicants traverse this statement.

Applicants’ specification states:

“The means for transferring the electrostatically charged coating particles comprise preferably a rotatable transfer roll or transfer belt on which the electrostatically charged coating particles are deposited by electrostatic forces and means for applying an electric field to transfer the electrostatically charged coating particles from the transfer roll or transfer belt to the film surface to be coated.”

“For that purpose the coating particles may be part of a two-component developer system with a carrier. The coating particles may, however, be part of a single-component developer system. Here “developer system” means a deposition system in which the particles are deposited on the substrate to be coated. Developer system has nothing to do here with the curing/hardening of the sealing layer.”

“The transfer of the coating particles to the film surface is carried out preferably by means of a process employing so called EMB-

Technology (Electro-Magnetic Brush Technology) such as is employed in particular in two-component developer systems. Here, a so called carrier is employed in the form of ferromagnetic particles, whereby the coating particles are attached to the carrier by tribo-electrical forces. The developer system comprising the carrier and the coating particles adhering to them is deposited over a rotating magnet roll facing the transfer roll or transfer belt. As a result of the magnetic forces acting between the magnet roll and the carrier the developer system is drawn in a chain-like manner to the magnet roll and forms a brush-like arrangement also known as magnet brush. The magnet brush strokes the transfer roll and creates a so called brush effect as a result of which the coating particles are transferred, with the aid of electrostatic forces to the electrostatically charged surface of the transfer roll. [Emphasis Supplied]

[Page 6, line 14, to page 7, line 9]

Applicants' Claim 2 is not indefinite and is fully supported and explained in applicants' disclosure. Claim 2 also points out and distinctly claims the subject matter which applicants' regard as the invention. The Examiner's assertion is incorrect in fact and law.

The terms "two-component developer system" and "two-component deposition system" can be used interchangeably, as shown at page 6, lines 23 to 25. Applicants have amended Claim 2 to use the former term to be more conformity with term usage in the specification.

This rejection should be withdrawn.

The Office Action stated that the following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 to 5, 18 and 19 have been rejected under 35 U.S.C. 102(b) as being anticipated by Handels et al. (U.S. Patent No. 6,342,273). Applicants traverse this rejection.

The Office Action stated: that the method applies paint/varnish particles to metal, paper, textile, or plastic substrates (including cardboard for packaging, col. 12, 52 and 53) wherein all or a part of the substrate is powder coated (col. 11, 51 and 52); the method is a powder transfer method comprising charging coating particles and mixing them with magnetic carrier particles, followed by contacting the mixture with a substrate, wherein an electric field transfers the powder to the substrate, after which the coated substrate is melted and fused by radiation or an oven (col. 11, 23, to col.12, 24); that transport means includes a magnetic brush apparatus and use of magnetic carrier particles, therefore a two component deposition system; that of photocopying technology (synonymous with electrophotographic) to move substrates and charge/apply powder is cited on col. 2, 54 to 62; that materials applied include polyesters, methacrylates, varnishes (same art meaning as lacquer), etc.; and that since applicants' specification,

page 2, lines 16 to 20, defines the “sealing layer” to be “in form of dry particles i.e. powder particles, and preferably in the form of a powder paint”, which can be electrostatically charged, the reference meets applicants’ limitation of depositing a sealing layer. Applicants’ traverse this statement.

Amended Claim 1 contains the subject matter of Claim 6 so Handels et al. does not anticipate amended Claim 1. The Examiner did not reject Claim 6 as being anticipated by Handels et al.

This rejection should be withdrawn.

The Office Action stated that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6 and 7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Handels et al. Applicants traverse this rejection.

The Office Action stated: that Handels et al. is cited for the same reasons

previously discussed, which are incorporated herein; and that specific coating and process details are not cited. Handels et al. does not teach or suggest the subject of Claims 6 or 7.

The Office Action stated: that however, as previously discussed, varnishes/lacquers are encompassed by the powder paints of Handels et al., and therefore the use of such powders to form a hot-sealing layer would have been obvious because the processes of the reference is cited for similar non-uniform powder paint coatings. Applicants disagree with this statement. Claim 1, as amended, requires a hot-sealing adhesive that can be thermally activated (see page 2, line 31, to page 3, line 2). The Examiner said that “the coated substrate” of Handels et al. was “melted and fused by radiation or an oven”. (See col. 11, lines 39 to 44, of Handels et al.) There is no assertion by the Examiner that Handels et al. suggests using a heat-sealing adhesive that is thermally activated. The adhesive properties of applicants’ heat-sealing layer are re-activated when heat is applied to melt the heat-sealing layer during the sealing operation. (See page 2, lines 12 to 14.) The Examiner’s assertion of obviousness is only speculation.

The Office Action stated that photocopying technology necessarily includes electronic data processing per Claim 7. Claim 1 is not obvious, so Claim 7 is not obvious.

The Office Action stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the process of Handels et al. using hot-sealing materials because applicants define

such materials in terms of powder paints, and coating technology using data processing to provide reproducibility of the non-uniform powder coatings.

Applicants traverse this statement. The Examiner has not factually determined in the record the level of ordinary skill in the art, so the Examiner does not know what would be obvious to such a person.

This rejection should be withdrawn.

Following the dictates of the Graham decision is mandatory of the Examiner. M.P.E.P. 2141, (Rev. 2, May 2004), states:

"Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations."

[Emphasis Supplied]

M.P.E.P. 2141.03, (Rev. 2, May 2004), states:

"ASCERTAINING LEVEL OF ORDINARY SKILL IS NECESSARY TO MAINTAIN OBJECTIVITY"

"The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry, 'Ryko

Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718, 21 USPQ2d 1043, 1057 (Fed. Cir. 1991). The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).” [Emphasis supplied]

M.P.E.P. 2144.08.II, (Rev. 2, May 2004), states:

“A proper obviousness analysis involves a three-step process. First, Office personnel should establish a *prima facie* case of unpatentability considering the factors set out by the Supreme Court in *Graham v. John Deere*. See, e.g., *In re Bell*. 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (The PTO bears the burden of establishing a case of *prima facie* obviousness.’); *in re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), requires that to make out a case of obviousness, one must:

- (A) determine the scope and contents of the prior art;
- (B) ascertain the differences between the prior art and the claims in issue;
- (C) determine the level of skill in the pertinent art; and

(D) evaluate any evidence of secondary considerations. If a *prima facie* case is established, the burden shifts to applicant to come forward with rebuttal evidence or argument to overcome the *prima facie* case.”

[Emphasis supplied]

Claims 8, 9, 22 and 23 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Handels in view of Liu et al. (U.S. Patent No. 6,376,148). Applicants traverse this rejection.

The Office Action stated that Handels et al. is cited for the same reasons previously discussed, which are incorporated herein; and that regulating thickness is not cited. Handels et al. does not make any of applicants' claims obvious.

The Office Action stated that Liu et al. teaches a powder coating layer application process, encompassing electrophotographic deposition, in which the thickness of applied layers are monitored by electronic sensors (col. 20, line 66 to col. 21, line 9, etc.) Liu et al. is not particularly relevant. The Examiner has not provided the necessary motivation in the record to combine Handels et al. and Liu et al. in the search for applicants' claimed invention.

The Office Action stated that, since Handels et al. teaches the requirements for specific thicknesses on col. 2, lines 35 to 38, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Handels by incorporating the concept of sensor means as taught of Liu et al. to monitor and assure the desired thickness of the applied powder coatings. Applicants traverse this statement. The Examiner knows nothing about one

ordinarily skilled in the art or what would be obvious to such a person. See above.

The Examiner has not established the required motivation to combine the rejection references. Merely saying that it is obvious to combine parts of the rejection references is insufficient.

The Office Action stated that, per Claim 9, the process cited is a continuous coating process to provide an economically feasible process for applying reproducible powder coatings. This is mere speculation without factual support in the record.

This rejection should be withdrawn.

The Examiner in the Notice said that the claim objection to duplicate claim had been established. This statement is incorrect. Claims 13 to 18 are in descending dependency from Claim 2 and accordingly consistently narrower scope. None of Claims 3, 4, 7, 8 and 9 have the same (or even substantially the same) scope as any of Claims 13 to 18. The Examiner has not factually shown otherwise in the record. The Examiner has not carried his burden of proof so the objection is still defective. Also, no claim has been allowed so the objection is defective on its face and ab initio.

Claims 3, 4, 7, 8 and 9 have been marked and are now compliant.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

4/14/06
Date

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